Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-20 are pending in the application, with 1 and 15 being the independent claims. Claims 15 and 20 are sought to be amended to correct typographical errors and/or better reflect originally recited embodiment(s) of Applicants' claimed invention. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner has rejected claims 1-20 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent 5,721,910 to Unger *et al.* (herein referred to as "Unger"). Applicants respectfully traverse.

a. Claims 1-14

For the Examiner's convenience, claim 1 is reproduced below:

A computer implemented method of enabling a user to organize and analyze information in electronic form, comprising the steps of:

- (1) searching a first set of documents to thereby generate a second **set of documents**;
- (2) automatically creating a first group comprising said second set of documents;

- (3) analyzing said first group according to one or more analytical functions to thereby generate a third **set of documents**;
- (4) automatically creating a second group comprising said third set of documents; and
- (5) enabling selective iteration of at least one of steps (1)-(4).

Unger does not teach each and every element, limitation, and/or feature of claim

1. For example, Unger fails to teach or suggest "a computer implemented method ...

enabling selective iteration of at least one of steps (1)-(4)."

Steps (1)-(4) of claim 1 generate or group a set of documents. As shown in Figure 30, Applicants' claimed invention enables this set of documents to be iterated through at least one of the steps (1)-(4) any arbitrary number of times. For example, as depicted in Figure 30, a set of documents generated in step (3) and grouped in step (4) may be searched using step (1) and this process may be repeated. Unger fails to teach or suggest this aspect of the Applicants' claimed invention.

Unger appears to disclose, in essence, a linear six stage process of disaggregating "a set of patents and/or technical documents into discrete technical categories ... The categorization may then be used ... to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents and/or patents" (See Unger at col 3, lines 9-25).

Unger does not teach or suggest that its linear six stage process enables selective iteration of its individual stages. Unger's six stage process takes distinct inputs, which are different in form, from its output (See Unger, Figure 1). For example, stage IV of Unger takes as input a Customized Technical Subject Hierarchy, ETS, patent abstracts,

patent claims, and technical documents. Stage IV of Unger outputs records in a table (See Unger at col. 7, lines 56-65). Since the output of stage IV of Unger is of a different form than its inputs, the output of stage IV cannot be applied iteratively as the input to stage IV of Unger again. Since each stage of Unger's six stage process takes distinct inputs, which are different in form, from each of its other stages, the output of one stage of Unger cannot be arbitrarily applied as an input to another stage of Unger (See Unger, Figure 1). Hence Unger suggests a technique in which each stage must be chained together in sequence.

Unlike Unger, Applicants' claimed invention contains steps whose inputs and outputs are of the same form, a set of documents. Since Applicants' claimed invention uses the same form of input and output, the output of one step may become the input of another step and therefore Applicants' claimed invention, unlike Unger, enables selective iteration (See, for example, step (5) of claim 1).

The Examiner cites to Col. 8 lines 50-62 of Unger to allege that Unger teaches the step of "enabling selective iteration of at least one of steps (1)-(4)." However, Col. 8, lines 50-62 of Unger does not suggest this aspect of the Applicants' claimed invention but merely shows that the initial stages of Unger's linear six stage process may be restarted before progressing to the next stage. Unger's process remains linear since the output of stage V cannot act as an input to stage III and so on.

Applicants' claimed invention is nonobvious over Unger. Unger teaches or suggests only a linear method of inputting actual patents and technical documents and obtaining a high-level overview (See Unger, Col 5, line 3 to Col 6, line 43). However,

Applicants' claimed invention enables a non-linear technique of searching and applying analytical functions to a set of documents to refine and produce desired results.

Accordingly, Unger does not teach or suggest Applicants' claim 1. Claims 2-14 depend from claim 1, and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-14, and allowance thereof.

a. Claims 15-20

For the Examiner's convenience, claim 15 as amended is reproduced below:

A computer implemented method of enabling a user to organize and analyze information in electronic form, comprising the steps of:

- (1) searching members of a first set of documents to thereby generate a second set of documents;
- (2) automatically creating a first group comprising said second **set of documents**;
- (3) analyzing said first group according to one or more analytical functions executed with respect to information stored in an external database, distinct from said first and second sets of documents, to thereby generate a third set of documents;
- (4) automatically creating a second group comprising said third set of documents; and
- (5) enabling selective iteration of at least one of steps (1)-(4).

Unger does not teach each and every element, limitation, and/or feature of claim

15. For the reasons described above, Unger fails to teach or suggest "a computer implemented method ... enabling selective iteration of at least one of steps (1)-(4)."

Accordingly, Unger does not teach or suggest Applicants' claim 15. Claims 16-20 depend from claim 15, and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-20, and allowance thereof.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Attorney for Applicants Registration No. 35,239

Date: September 9, 2004

1100 New York Avenue, N.W. Washington, D.C. 20005-3934 (202) 371-2600

285504.1